



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of:
Jonathan Dorfman

Application No.: 09/372,416

Group Art Unit: 2178

Filed: August 11, 1999

Examiner: Huynh, Thu V.

For: System and method for real-time bidding for
Internet advertising space

RENEWED REQUESTS UNDER 37 C.F.R. § 1.48
AND RENEWED PETITIONS UNDER 37 C.F.R. 1.183

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a request for reconsideration of the Decision on Petition dated September 6, 2011 ("Decision").

The Decision dismissed the request pursuant to 37 C.F.R. § 1.48, that sought to add Mr. David William Roth as a named inventor in this application and to delete Mr. Jonathan Dorfman from the inventorship of this application. The Decision also dismissed the petitions pursuant to 37 C.F.R. § 1.183 that sought waivers of certain requirements of § 1.48 and § 1.63.

Applicant is the Assignee of the present application and is prosecuting the present application under 37 C.F.R. § 3.71. A statement under 37 C.F.R. § 3.73(b) is submitted herewith.

Applicant respectfully requests reconsideration of the dismissal.

The central reason for the dismissal of the aforementioned requests and petitions is due to the fact that Applicant failed to submit the showing of record made in Application No. 09/216,206 (the "'206 Application") that Mr. Roth cannot be found or reached after diligent effort.

In the '206 Application, Applicant submitted a showing that Mr. Roth cannot be reached

at several addresses that were associated with Mr. Roth. Those addresses however were apparently addresses of Mr. Roth's former residences. Mr. Roth's most current address could not be located.

Applicant has now been able to identify Mr. Roth's current residence and mailing address as follows:

**88 Perry Street #740
San Francisco, California 94107**

Applicant has been unable to communicate with Mr. Roth at this address. Enclosed herewith is a statement by Mr. Benzion A. Wachsman in support of the renewed petitions and requests.

For the foregoing reasons, Applicant respectfully request reconsideration of the Decision dismissing the requests and petitions.

Dated: November 7, 2011

Respectfully submitted,

BEH Investments LLC *

Signature: /Benzion A. Wachsman/

Name: Benzion A. Wachsman

Title: General Manager

Tel.: (718) 928-2213

Fax: (718) 504-9671

*A statement pursuant to 3.73(b) is attached.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jonathan Dorfman

Application No.: 09/372,416

Group Art Unit: 2178

Filed: August 11, 1999

Examiner: Huynh, Thu V.

For: System and method for real-time bidding for
Internet advertising space

STATEMENT BY BENZION A. WACHSMAN
IN SUPPORT OF REQUESTS UNDER 37 C.F.R. § 1.48
AND PETITIONS UNDER 37 C.F.R. 1.183

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The undersigned, Benzion A. Wachsman, hereby submits this statement in support of Requests under 37 C.F.R. § 1.48 and Petitions under 37 CFR § 1.183.

I am a principal of BEH Investments LLC, the current assignee for the above-identified application. I have first-hand knowledge of the information recited herein.

A new address for Mr. David William Roth was identified at 88 Perry Street #740, San Francisco, California 94107.

Attached as "Exhibit A" is a resume Mr. Roth posted online at <http://pangloss.4t.com/progd-fixed.htm>. The resume shows Mr. Roth's current address at 88 Perry Street # 740, San Francisco California.

The phone number shown on the resume is (415) 515-1001. I called this number; however, the answering machine announcement was by a Ms. Suzanne Heske. The phone number does not appear to be presently associated with Mr. Roth.

The email address listed on the resume is imdwr@yahoo.com. An email was sent to this

email address on September 6, 2011 a copy of which is attached as "Exhibit B". No response was received from Mr. Roth to the email.

The resume indicates that Mr. Roth was employed by Yerba Buena Commons (YBC) between 2002 and 2007 as a computer programmer. YBC is the owner and manager of the apartment building at 88 Perry Street. I contacted YBC and was informed by a Mr. Mitch Brown that Mr. Roth is no longer employed by YBC.

In September 2011, I retained Kale Investigation Agency, a private investigating firm, to seek confirmation whether Mr. Roth continues to reside at the aforementioned address. The investigator confirmed that Mr. Roth continues to reside at 88 Perry Street in San Francisco. Attached as "Exhibit C" is a copy of the investigator's detailed report.

On October 3, 2011, I sent the letter attached as "Exhibit D" to Mr. Roth at the above address. The letter was sent via FedEx and required Mr. Roth's signature for delivery. FedEx was unable to deliver the letter after three attempts at delivery. Attached as "Exhibit E" is a copy of the FedEx shipping label and a copy of the online FedEx tracking information.

On October 10, 2011, I sent the letter attached as "Exhibit F" by regular postal mail to Mr. Roth.

Mr. Roth has to date not responded to the letter of October 10, 2011.

Dated: November 7, 2011

Respectfully submitted,

Signature: /Benzion A. Wachsman/

Name: Benzion A. Wachsman

EXHIBIT A

88 Perry Street #740
San Francisco, CA 94107

Phone 415 515-1001
E-mail imdwr@yahoo.com

David Roth

Objective	A critical position designing, developing and maintaining software client/server applications.		
Expertise	Over twenty years experience designing, developing and successfully shipping software products. Tools: Java, C, XML, SQL/PLSQL (MySQL/JDBC, also Oracle), Swing, SAX, SOAP, JavaScript; Unix (Posix) and Windows XP.		
Professional experience	2002-2007	Yerba Buena Commons	San Francisco, CA
	Java Programmer		
	Designed, developed and maintained Java apps and applets running on Windows XP to allow data collection, reporting and database maintenance, using MySQL/JDBC, Java Swing UI under Java v6/netbeans. Installed and maintained software on the Integral Video Server.		
	2000-2002		
	Independent Software Consultant		
	<ul style="list-style-type: none">Wilson Vending: Designed and implemented vending business application using C and Java and AWT UI. Also utilized JDBC and MySQL; used Java HTTPRequest protocols to access vendor data.Times Tribune Zap2it labs (on spec): Designed and implemented a TV guide browser using their XTVD web service; utilized XML, WSDL, XSD, SAX and SOAP protocols using Java v6.Transcape: Recommended and coded changes to a video games application using Windows Media and C.		
	1997-1999	Flycast Communications	San Francisco, CA
	Co-Founder and Technical Chief		
	Chief designer and developer of the ADEX Web-based ad delivery system, using C, C++, SQL and PL/SQL (Oracle) running on UNIX. Designed Java client running on Windows using Java Web Start for updates. Hired and managed the technical staff from start-up to successful product launch. Managed the design and development of the desktop Buyer application using Java, and web-based Seller applications. Responsible for product QA. Holder of multiple patents for ad-brokering software. Participated in presentations to investors, customers and employees. Flycast did a stock offering and was later sold.		
	1986-1996	Gupta Technologies	San Francisco, CA
	Senior Software Engineer		

Designed and developed improvements and extensions of SQLBase, the first Oracle-compliant PC SQL database, including query optimizations and language extensions, using C running on Windows. Co-designer and developer of SQLWindows, one of the first fourth-generation visual database application design environments. SQLWindows shipped over 100,000 run-times and became the company flagship product. Co-holder of one of the earliest software patents for SQLWindows.

Education	1976-1979	University of California	Irvine, CA
	B.S Computer Science / B.A Mathematics		
	Earned 2 degrees in 3 years. Magnum cum laude, Dean's list.		
References	On request.		
Hobbies	Keyboards, guitar, Maya 3D graphics, cryptic crosswords.		

EXHIBIT B

Benzion Wachsman

From: "Benzion Wachsman" <wachsman@gmail.com>
To: <imdwr@yahoo.com>
Sent: Tuesday, September 06, 2011 5:51 PM
Subject: U.S. Patent No. 6,285,987 (Flycast Communications Corp.)
Dear Mr. Roth,

My company has acquired patents for inventions that you developed during your employment at Flycast Communications Corp. in San Francisco, CA, and for which you are named as co-inventor along with Mr. Dylan Salisbury. Included in the patents is U.S. Patent No. 6,285,987, entitled, "Internet Advertising System". In order to perfect our interests in the patents we require technical help and some background information regarding the development of the technology. I would greatly appreciate if you can assist us in this matter. We will compensate you well for your time and services.

Please contact at me your earliest convenience to discuss.

Thank you.

Ben Wachsman
BEH Investments LLC
t. (718) 928-2213
f. (718) 504-9671
c. (718) 812-0036

11/7/2011

EXHIBIT C



Kale Investigation Agency

Established 1968 Licensed and Bonded by the State of California, License Numbers PI 4748 AJ-2683162 - IRS No 95-3961298

Corporate Offices
8221 E. 3rd Street, Suite 400
Downey, CA 90241

Tel: (562) 869-2535
Fax: (562) 869-5268

Website: <http://www.kaleinvestigation.com>
E-mail: dkalepi@earthlink.net

INVESTIGATION REPORT

TO: Mr. Benzion A. Wachsman
1652 48th Street
Brooklyn, NY 11204
Attn.: Mr. Wachsman

RE: DATE : September 22, 2011
KALE REPORT NO. : 18405-C
SUBJECT : David William Roth
SERVICES : Locate Investigation
REPORT BY : M. Walker
Kale Investigation Agency

THIS COMMUNICATION REPORT AND ALL INFORMATION CONTAINED HEREIN IS TO BE CONSIDERED AS BEING OF A CONFIDENTIAL NATURE AND MAY BE SUBJECT TO PRIVILEGE UNDER THE ATTORNEY/CLIENT WORK PRODUCT PRIVILEGES.

INVESTIGATIVE ASSIGNMENT:

The Kale Investigation Agency was contacted by our client, Benzion A. Wachsman, and we were requested to locate a male subject by the name of David William Roth, hereafter referred to as Subject in this report.

Subject can best be described as being about 52 years of age. We were provided with a new possible address for the Subject given as 88 Perry Street, #740 in San Francisco, CA.

TO: Benzion A. Wachsman
RE: Locate Investigation

DATE : Sept. 22, 2011
KALE REPORT NO. : 18405-C~Page 2

INVESTIGATOR'S DETAILED REPORT:

This assignment, first received last week, while Investigator was out of state on a litigation matter, was reaffirmed on Tuesday, 20 September 2011 and substantially completed the following day.

We had last looked for Mr. David William Roth in July 2009, in the Richmond District of San Francisco, California. We also followed other informational traces for him into Mountain View, a town south of San Francisco, without any positive results.

We are pleased to announce that this time; we were able to locate the current residence of Mr. Roth at the precise address where your information stated he would be, 88 Perry Street, Apt. 740, San Francisco, California.

The location is adjacent to the Bay Bridge. It is a modern exterior appearance apartment building, without any signage or even a permanent exterior address attached. The front entrance is an electronically controlled access point with a high security-gated garage. The apartments within the structure themselves have the appearance of modern hotel rooms, with electronic key card access, instead of metal keys. A sequential series of digital photographs follow, showing what our Investigator observed during the visit.

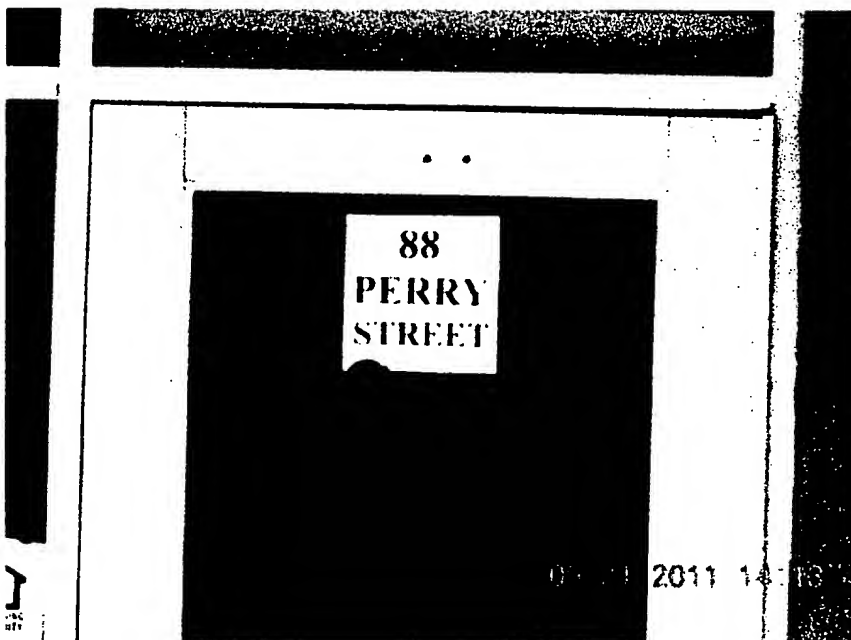
As shown in the photography sequence below, especially the floor diagram, Mr. Roth resides on the far end of the seventh floor from the elevators, across the hallway from one of the three fire exits at this level.

Efforts to establish personal contact with him were unsuccessful. However, after leaving the seventh floor, our Investigator stopped by the building managers office on the fourth floor and spoke with Mr. Gabe Lira, of YBC Associates Inc., who was quick to confirm Mr. Roth was still in residence, even though he had not seen him in the past couple days.

Before and after the actual location inquiry we left voice mail for Mr. Waxman, your client, whose number you had provided earlier. Mr. Waxman called later in the day to express his gratitude for the successful location contact results and related he would be pursuing the next step in the inquiry process.

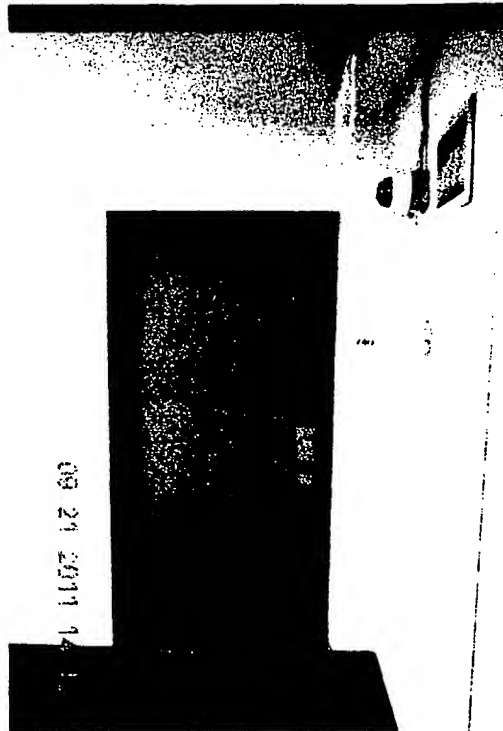
TO: Benzion A. Wachsman
RE: Locate Investigation

DATE : Sept. 22, 2011
KALE REPORT NO. : 18405-C~Page 3

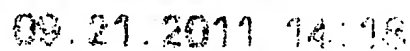


TO: Benzion A. Wachsman
RE: Locate Investigation

DATE : Sept. 22, 2011
KALE REPORT NO. : 18405-C~Page 4



DATE : Sept. 22, 2011
KALE REPORT NO. : 18405-C~Page 5



*** END OF REPORT ***

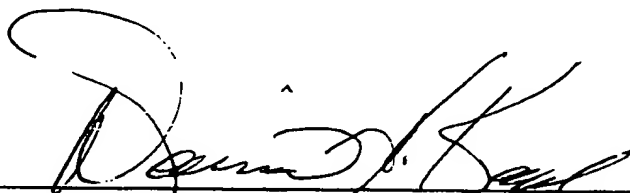
TO: Benzion A. Wachsman
RE: Locate Investigation

DATE : Sept. 22, 2011
KALE REPORT NO. : 18405-C~Page 6

CLOSING REMARKS:

The above reflects the status of our investigation in this case to date. If you should have any comments, suggestions, or further instructions regarding this assignment, please do not hesitate to call me at (562) 869-2535. Our invoice is enclosed for services rendered in accordance with this assignment.

We look forward to being of continuing assistance in the near future. Thank you for the opportunity to be of service.



KALE Investigation Agency/Insurance Adjusting Company
David H. Kale - Director

DHK:MW:ks

Enclosures: Invoice
Photographs

EXHIBIT D

BEH INVESTMENTS LLC
1652 48TH STREET, BROOKLYN, N.Y. 11204
TEL.: (718) 928-2213 / FAX: (718) 504-9671

October 3, 2011

VIA FEDEX

Mr. David W. Roth
88 Perry Street, Suite No. 740
San Francisco, California 94107

**Re: U.S. Patent No. 6,285,987 & Continuation Applications Nos. 09/216,206,
09/372,416, 11/926,939, 11/933,080, 11/933,122.**

Dear Mr. Roth,

BEH Investments LLC, the current owner of the above-captioned patent has filed continuation applications with additional claims. To that end, we are required to file an Inventor's Declaration with the United States Patent & Trademark Office. As you are a named inventor on the above-captioned patent and continuations, we kindly request your assistance in this matter. We are seeking your review of the claims and signature on the Inventor's Declaration.

Enclosed is a copy of the original Assignment for the invention which sets forth the terms and conditions for future assistance by the inventors with regards to the assigned invention.

We would like to compensate you for your time and efforts in assisting us with this matter at the rate of \$300/hour. The time estimated for this request is about 20 hours. I expect however that as we continue to pursue the continuations we may seek your consultation in the future as well.

Please contact me to discuss the above at your earliest possible convenience. You can contact me via telephone at (718) 928-2213, cellular phone at (718) 812-0036, or email at wachsman@gmail.com.

Thank you very much.

Very truly yours,

Benzion Wachsman

Benzion A. Wachsman
General Manager

ASSIGNMENT

In consideration of good and valuable consideration, the receipt of which is hereby acknowledged, we the undersigned,

David William Roth

whose address is 3650 Fillmore St. #304, San Francisco, CA 94123, and

Dylan Salisbury

whose address is 2854 Golden Gate Ave., San Francisco, CA 94118

1. Hereby sell, assign and transfer to Orst Inc. a corporation of California, having a place of business at 123 Townsend St. Suite 226, San Francisco, CA 94107. Its successors, assigns and legal representatives, the entire right, title and interest for the United States and all foreign countries:

(a) in and to any and all inventions which are disclosed in the application for United States Letters Patent, which was executed by the undersigned and is:

Entitled: Internet Advertising System
Date Executed: 20 Jan 1997
Docket Number: EWG-053

(b) in and to said application and all divisional, continuing, substitute, renewal, reissue, and all other applications for Letters Patent which have been or shall be filed in the United States and all foreign countries on any of said inventions; and (c) in and to all original and reissued patents which have been or shall be issued in the United States and all foreign countries on said inventions;

2. Agree that said Assignee may apply for and receive Letters Patent for said inventions in its own name; and that, when requested, (at the expense of said Assignee, its successors, assigns and legal representatives), the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns, and representatives, all facts known to the undersigned relating to said inventions and the history thereof; and generally do everything reasonable which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing and maintaining proper patent protection for said inventions and for vesting title to said inventions and all applications for patents and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives, and

3. Covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned

Date: 20 Jan 97

Signature: David William Roth

Date: 20 Jan 97

Signature: Dylan Salisbury

G:\FLYCAST\053-FIN\053A88N14

RECORDED: 01/22/1997

PATENT
REEL: 8368 FRAME: 0114

EXHIBIT E

FedEx® US Airbill

Tracking Number

8695 8344 9761

Express

1 From Please print and press hard
Date 10/03/2011 Sender's FedEx Account Number

Sender's Name Benzion Wachsman Phone ()

Company BEH Investments LLC

Address 1652 48th Street

City Brooklyn State N.Y. ZIP 11204

2 Your Internal Billing Reference

3 To Recipient's Name David W. Roth Phone ()

Company

Recipient's Address 88 Perry Street Suite 740

Address To request a package be held at a specific FedEx location, print FedEx address here.

City San Francisco State CA ZIP 94107



Sender's Copy

4a Express Package Service

☒ FedEx Priority Overnight ☐ FedEx Standard Overnight ☐ FedEx First Overnight

☐ FedEx 2Day ☐ FedEx Express Saver ☐ FedEx 3Day Freight

☐ FedEx 1Day Freight

4b Express Freight Service

☐ FedEx 1Day Freight

5 Packaging

☒ FedEx Envelope ☐ FedEx Pak ☐ FedEx Box ☐ FedEx Tube ☐ Other

6 Special Handling

☐ SATURDAY Delivery

☐ HOLD at FedEx Location

☐ NOT Available for FedEx First Overnight, FedEx Express Saver, or FedEx 2Day Freight

7 Payment Bill to: ☐ Sender ☐ Recipient ☐ Third Party ☒ Credit Card ☐ Cash/Check

8 Residential Delivery Signature Options

☐ No Signature Required ☒ Direct Signature ☐ Indirect Signature

Total Packages 1 Total Weight 1.16 lbs Total Declared Value \$ 2.00

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Detailed Results

Tracking no.: 869583449761

Select time format: 12H

In transit

At FedEx destination facility
SAN FRANCISCO, CA

Shipment Dates

Destination

Ship date Oct 3, 2011

Shipment Options

Hold at FedEx Location

Not available to receive your shipment? FedEx will hold your shipment at a nearby FedEx location at no extra cost. Some shipments may not be eligible for this service.

Shipment Facts

Service type Priority Envelope - Direct Signature
Required
Weight 0.5 lbs/2 kg

Shipment Travel History

Select time zone: Local Scan Time

All shipment travel activity is displayed in local time for the location

Date/Time	Activity	Location	Details
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Oct 6, 2011 12:05 PM	At local FedEx facility	SAN FRANCISCO, CA	
Oct 6, 2011 9:21 AM	Delivery exception	SAN FRANCISCO, CA	Customer not available or business closed
Oct 6, 2011 8:28 AM	On FedEx vehicle for delivery	SAN FRANCISCO, CA	
Oct 5, 2011 1:13 PM	At local FedEx facility	SAN FRANCISCO, CA	
Oct 5, 2011 1:06 PM	At local FedEx facility	SAN FRANCISCO, CA	
Oct 5, 2011 9:48 AM	Delivery exception	SAN FRANCISCO, CA	Customer not available or business closed
Oct 5, 2011 8:07 AM	On FedEx vehicle for delivery	SAN FRANCISCO, CA	
Oct 4, 2011 8:12 PM	At local FedEx facility	SAN FRANCISCO, CA	
Oct 4, 2011 5:59 PM	At local FedEx facility	SAN FRANCISCO, CA	
Oct 4, 2011 10:26 AM	Delivery exception	SAN FRANCISCO, CA	Customer not available or business closed
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Oct 4, 2011 7:35 AM	At local FedEx facility	SAN FRANCISCO, CA	
Oct 4, 2011 6:36 AM	At destination sort facility	SAN FRANCISCO, CA	
Oct 4, 2011 4:55 AM	Departed FedEx location	MEMPHIS, TN	
Oct 4, 2011 12:22 AM	Arrived at FedEx location	MEMPHIS, TN	
Oct 3, 2011 9:01 PM	Left FedEx origin facility	BROOKLYN, NY	
Oct 3, 2011 7:14 PM	Picked up	BROOKLYN, NY	

EXHIBIT F

BEH INVESTMENTS LLC
1652 48TH STREET, BROOKLYN, N.Y. 11204
TEL.: (718) 928-2213 / FAX: (718) 504-9671

October 10, 2011

Mr. David W. Roth
88 Perry Street, Suite 740
San Francisco, California 94107

**Re: U.S. Patent No. 6,285,987 & Continuation Applications Nos. 09/216,206,
09/372,416, 11/926,939, 11/933,080, 11/933,122.**

Dear Mr. Roth,

BEH Investments LLC, the current owner of the above-captioned patent has filed continuation applications with additional claims. To that end, we are required to file an Inventor's Declaration with the United States Patent & Trademark Office. As you are a named inventor on the above-captioned patent and continuations, we kindly request your assistance in this matter. We are seeking your review of the claims and signature on the Inventor's Declaration.

Enclosed is a copy of the original Assignment for the invention which sets forth the terms and conditions for future assistance by the inventors with regards to the assigned invention.

We would like to compensate you for your time and efforts in assisting us with this matter at the rate of \$300/hour. The time estimated for this request is about 20 hours. I expect however that as we continue to pursue the continuations we may seek your consultation in the future as well.

Please contact me to discuss the above at your earliest possible convenience. You can contact me via telephone at (718) 928-2213, cellular phone at (718) 812-0036, or email at wachsman@gmail.com.

Thank you very much for your anticipated cooperation.

Very truly yours,

Benzion A. Wachsman
General Manager

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jonathan Dorfman

Application No.: 09/372,416

Group Art Unit: 2178

Filed: August 11, 1999

Examiner: T. V. Huynh

For: System and method for real-time bidding for
Internet advertising space

STATEMENT UNDER 37 CFR § 3.73(b)

BEH Investments LLC, a Delaware limited liability corporation, states that it is the assignee of the entire right, title and interest in the patent application identified above, by virtue of a chain of title from the inventor of the patent application identified above, to the current assignee as shown below:

1. From: David W. Roth; Dylan F. Salisbury To: Orst, Inc.
The document was recorded in the United State Patent and Trademark Office at Real 008368, Frame 0113.
2. From: Orst, Inc. To: Flycast Communications Corp.
The document was recorded in the United State Patent and Trademark Office at Real 009836, Frame 0118.
3. From: Flycast Communications Corp. (a California Corporation)
To: Flycast Communications Corp. (a Delaware Corporation)
The document was recorded in the United State Patent and Trademark Office at Real 017811, Frame 0238.
4. From: Orst, Inc. To: Engage, Inc.
The document was recorded in the United State Patent and Trademark Office at Real 011903, Frame 0079.
5. From: Jonathan Dorfman To: Flycast Communications Corp.
The document was recorded in the United State Patent and Trademark Office at Real 010167, Frame 0961.
6. From: Flycast Communications Corp. To: Engage Technologies
The document was recorded in the United State Patent and Trademark Office at Real 012077, Frame 0149.
7. From: Engage Technologies To: Engage, Inc.

The document was recorded in the United State Patent and Trademark Office at
Real 012592, Frame 0308.

8. From: Engage, Inc. To: BEH Investments LLC

The document was recorded in the United State Patent and Trademark Office at
Real 013936, Frame 0257.

9. From: Craig R. Jalbert, Liquidating Supervisor of Engage, Inc.

To: BEH Investments LLC

The document was recorded in the United State Patent and Trademark Office at
Real 018535, Frame 0073.

The undersigned is duly authorized to act on behalf of Assignee.

Dated: July 20, 2011

Respectfully submitted,

Signature: /Benzion A. Wachsman/

Benzion A. Wachsman

General Manager

BEH Investments LLC

Tel.: (718) 928-2213

Fax: (718) 504-9671